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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,601	02/28/2002	Akihiro Kuroda	3094-39	7638

7590 12/27/2004

Pitney Hardin Kipp & Szuch
685 Third Avenue
New York, NY 10017-4024

EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/070,601

Applicant(s)

KURODA ET AL.

Examiner

Gina C. Yu

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. § 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1 and 3-25.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

Continuation of No. 5:

Examiner maintains the rejection for the reasons as explained in the previous Office action dated July 14, 2004. Applicants assert that one of ordinary skill in the art would not have been motivated to combine Suzuki with Sakuta allegedly because methytris(trimethylsiloxy)silane (M3T) was merely used as a diluent in polymerization rather than a cosmetic component. Examiner respectfully disagrees. Also taught in the Sakuta reference is the equivalence of M3T with other low-viscosity silicone oils that are well known in cosmetic art, including cyclic dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which are also used in Suzuki. It is viewed that substituting one low viscosity silicone with another that are taught in Sakuta would have been obvious to the skilled artisan. There is sufficient motivation to modify the Suzuki cosmetic composition with a reasonable expectation of successfully producing a similar cosmetic product.

Applicants also assert that M3T provides "improved cosmetic properties" over other low-viscosity silicone oils. The comparison data in specification pp. 36-38 were fully considered. While it is not clear what "D4" component is, nonetheless it is noted that the specification shows evaluation results by 10 panelists who reported that the compositions comprising M3T provides "durability for coverage " and "fresh feel" than compositions comprising D5 (decamethylcyclopentasiloxane) by 42 and 39, compared to 29 and 16, respectively. Examiner views that the evidence does not sufficiently to show nonobvious or unexpected results. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art

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cannot be the basis for patentability when the differences would otherwise be obvious.

See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, M3T and decamethylcyclopentasiloxane are art-recognized substitute for each other.

Examiner views that the minor difference in the reported sensory opinions may be due to different properties of the M3T compound itself, which would naturally flow from using it in a cosmetic composition as motivated by the combined teachings of the references, rather than a greater than expected result. See MPEP § 716.02. Examiner also takes the position that opinion evidence alone cannot be given probative value to determine the ultimate legal conclusion of whether the present invention is an obvious variation of the prior arts. See MPEP § 716.01(C).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner